

Remarks

Claims 1, 5, 7, 10 13, and 42 have been amended, claims 4 and 9 have been cancelled, and new claim 43 and 44 have been added. Review and reconsideration of the amendments are respectfully requested.

Claims 1, 2, 4-13, 15-17, 19-32 and 34-42 are rejected as being anticipated by U.S. Pat. No. 5,042,841 to Friedman. Accordingly, claim 1 has been amended to include the subject matter of claims 4 and 9, and claims 4 and 9 have been cancelled. Furthermore, claim 1 has been amended to specify that: 1) the pouch has a first generally flat, planar panel and a second generally flat, planar panel oriented generally opposite to the first panel; 2) the rear cover has a size and shape similar to the pouch; 3) the notebook is movable to a closed position such that the stack of papers is located between the pouch and the rear cover; 4) the first panel is located between the second panel and the stack of papers when the notebook is in the closed position; and 5) the mouth is located on the second panel of the pouch so that the mouth can be accessed when the notebook is in its closed position.

Thus, for example, as shown in Fig. 1 of the present application, when the notebook is in its closed position the mouth 38 faces upwardly and can be accessed. In contrast, when the device of the Friedman reference is in its closed position, the mouth of the pocket faces down and is blocked from access. At paragraph 23 of this application the advantage of this feature is stressed wherein it is noted that the cavity provides a convenient and accessible place to store coupons and other small objects. In contrast, in the device of the Friedman reference, the cover must be open in order to access the pocket, and thereby provides less convenient and less accessible storage.

Furthermore, at column 3, lines 5-8, the Friedman reference emphasizes that the flap 26 will automatically close the pocket opening 22 when the binder 34 is closed. This passage teaches against any proposed re-arranging of the pocket such that the pocket opening 22 is located on an opposite side of the pocket. Thus, it is submitted that amended claim 1 defines over the Friedman reference. Independent claim 42 has been amended in a manner similar to that of claim 1 and it is therefore submitted to be allowable for the same reasons.

Claim 13 has been amended to specify that the longitudinal edges are longer than the lateral edges to further clarify the meaning of "lateral" and "longitudinal." It is submitted that

this amendment is not a narrowing amendment, as the terms "lateral" and "longitudinal," when used together, indicate that the longitudinal edges are longer than the lateral edges.

With respect to claim 13, the Office action refers to the rejection of claim 11 which takes the position that the pocket of the Friedman reference is bound to the stack of papers along one of the lateral edges. However, as can be seen in Fig. 1 of the Friedman reference, the pocket is in fact bound along one of its longitudinal edges. Thus, it is submitted that the rejection of claim 13 is improper and should be withdrawn.

Furthermore, it is noted that claim 14 specifies that each longitudinal edge is about twice as long as each lateral edge. The Office action rejects claim 14 as being unpatentable over the Friedman reference, and takes the position that a change in size is generally recognized as being within the level of ordinary skill in the art.

This rejection is respectfully traversed, as the subject matter specified in claims 13 and 14 provides specific advantages. As noted at, for example, paragraphs 2, 3, 5, 18 and 23 of this application, the notebook of the present invention may be utilized as grocery store lists and the like, and may include lined pages to aid a user writing lists thereon. Of course, a grocery list typically includes a list of relatively short words arranged in a vertical fashion. Thus, the notebook of the present invention is particularly sized and arranged (i.e. in a vertical configuration with the binding mechanism along the top edge) to match the configuration of a shopping list. However, the Friedman reference, and the Office action, do not point to any motivation for the proposed modification other than a broad generalization that a change of size is generally within the ordinary skill in the art. However, the size and arrangement specified in claims 13 and 14 is not a mere change in size without any thought or design; instead, the size and shape is specifically selected and engineered to match an expected manner of usage.

In addition it is submitted that the Friedman reference cannot be modified in the manner suggested in the Office action (which proposes a change in "size"). In particular, at column 2, lines 67-68 of the Friedman reference it is indicated that "conventional content paper 38" is utilized in the device of the Friedman reference. Thus the paper stored therein has a standard and well-defined shape so that the paper can be easily commercially obtained and can be easily stored in other paper storage components sized to store conventionally-sized paper.

Accordingly, it would not be obvious to one of ordinary skill in the art to change the size of that device.

Furthermore, with respect to the "lateral" and "longitudinal" orientation of the cover 10, it is submitted that it would not be obvious to one of ordinary skill in the art to bind along a lateral edge of the pocket 10 of the Friedman reference. In particular, if the binding mechanism 36 of the Friedman reference were moved to a lateral edge (i.e., top) of the pocket 10, then significant re-arrangement of the device of the Friedman reference would be required. In particular, in order to rearrange the device of the Friedman reference so that it is bound along a lateral edge: 1) the binding mechanism 26 would have to be moved to a lateral edge of the pocket 10, 2) the mouth and VELCRO® tab 42 would have to be moved along the lateral edge, 3) the flap 26 would have to be moved along the lateral edge, 4) the sheets of paper 38 would have to be moved and rearranged such that their lateral edges are coupled to the lateral edge of the cover 10, and 5) the back cover 45 would have to be moved and reconfigured such that its lateral edge is located adjacent to the lateral edge of the pocket 10.

However, the Friedman reference does not provide any teaching or disclosure for such a modification, and it is submitted that the Office action does not provide sufficient motivation for this severe and drastic redesign of the device of the Friedman reference (*see* MPEP §2143.01, citing to *In re Ratti*, 270 F.2d 810 (CCPA 1959) in which the court reversed the rejection of the claims on the basis that the proposed combination would "require a substantial reconstruction and redesign" of the components of the primary reference). Thus it is submitted that claim 13 (as well as claims 11, 14 and 40) are patentable over the cited references, and it is requested that the rejection thereto be withdrawn.

Claim 28 specifies that the pouch is generally transparent such that a top one of the stack of papers is visible to the pouch when no objects are received in the pouch. The Office action refers to portions of the Friedman reference which indicate that the pouch can be made from a variety of materials such as heavy bond paper, drafting board, inexpensive plastic sheet material and the like. The Office action takes the position that the disclosure of the Friedman reference would "inherently" include a transparent material.

However, the rejection on this basis is strongly traversed. The heavy bond paper, drafting board, and inexpensive plastic sheets are nowhere described as being transparent.

Nowhere in the Friedman reference can any suggestion, teaching or even passing reference to a "transparent" material be found. The Friedman reference does not include any disclosure to support the position advanced in the Office action.

The Office action appears to be making a rejection based upon an alleged "inherent" disclosure of the Friedman references. However, as noted in MPEP §2112 (citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)):

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

(emphasis added)

It is clear that the Office action does not provide that "makes clear" that the materials of the pouch of the Friedman are "necessarily" transparent. In fact, the Friedman reference does not even suggest or disclose that any of the material disclosed therein may be transparent.

As noted in paragraph 22 of the pending application, the transparent nature of the pouch allows the top sheet of the stack of sheets to be viewed. Thus, the transparent nature of the pouch provides a definite, clearly specified functional advantage. In contrast, the Friedman reference does not address any similar advantages that would propose or suggest making the pouch of that reference transparent. Under the reasoning advanced in the Office action, nearly any material property of the pouch would be rendered obvious over the listing of several types of material provided in the Friedman reference. Thus it is submitted that the subject matter of claim 28 (as well as claims 6, 8, 21, 23 and 37) is not shown in the Friedman reference, and that the rejection thereto should be withdrawn.

New claims 43 and 44 further define over the cited references. The subject matter of claims 43 and 44 is shown in the drawings accompanying the original application, as well as paragraph 19.

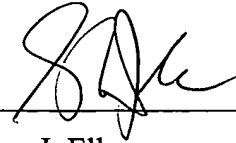
Accordingly, it is submitted that the application is now in a condition for allowance and a formal notice thereof is respectfully solicited.

The Commissioner is hereby authorized to charge any additional fees required, including the fee for an extension of time, or to credit any overpayment to Deposit Account 20-0809. The

Serial No.: 10/607,888
Attorney Docket No.: 100041-41191
Amendment

applicant(s) hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Elleman', is written over a horizontal line.

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